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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,030	11/04/2003	Thomas L. Kelly	KES-0004	6735
23413 7590 12/21/2006 CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER JUNKER, JONATHAN T	
			ART UNIT	PAPER NUMBER
			3635	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/21/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/702,030

Applicant(s)

KELLY, THOMAS L.

Examiner

Jonathan T. Junker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a first action on the merits, Claims 1-13 are pending and are examined below.

#### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings provided with the application are not well understood. For example, the line quality is unintelligible by the examiner. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Specification***

The abstract of the disclosure is objected to because the abstract contains legal phraseology. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

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abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: The term "EPDM" is used on the third line of the claim, the acronym should be accompanied or preceded by a description of what the acronym represents. Appropriate correction is required.

Claim 12 is objected to because of the following informalities: The word "adsorbing" is used, which the examiner believes is a misspelling of the word "absorbing". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 recites the limitation "the roofing membrane" on the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. The claim depends from Claim 1 in which the term "roofing membrane" has not been introduced.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claim 1-6, and 8-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Carr, III et al. US Patent 6,502,360.**

Regarding claim 1, Carr, III et al. discloses an apparatus that can be assembled by the method of reducing roof membrane damage from hail/fastener impact comprising: locating a fastener (16 fig 1) in a roof construction; positioning an energy absorbing material (20 fig 1) over said fastener whereby said fastener is completely covered by said material; and affixing (18 fig 1, the asphalt material 18 affixes the energy absorbing material to the fasteners) said material to said fastener.

Regarding claim 2, Carr, III et al. discloses an apparatus that can be assembled by the method of reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said affixing is by adhering (18 fig 1).

Regarding claim 3, Carr, III et al. discloses an apparatus that can be assembled by the method of reducing roof membrane damage from hail/fastener contact as claimed in Claim 2 wherein said adhering is by a self stick adhesive (18 fig 1) applied to

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said energy absorbing material. It is noted that the asphalt layer would act as an adhesive to bond layers 22 and 24 to layer 14 in figure 1.

Regarding claim 4, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate (12 fig 1) having one or more layers of material; at least one fastener (16 fig 1) exposed at a top surface of said substrate; a dedicated energy absorbing material (20 fig 1) positioned over said at least one fastener; and a roof waterproofing membrane (22 fig 1) positioned atop all foregoing elements.

Regarding claim 5, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said one or more layers of material includes insulation (12 fig 1). It is noted that any of the layers can be considered an insulating layer because the layers would provide as some form of insulation.

Regarding claim 6, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is cover tape (20 fig 1). It is noted that the cover tape 20 is the combination of layers 22 and 24 in figure 1.

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Regarding claim 8, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is ethylene propylene diene monomer (22 fig 1, column 2 lines 58-59).

Regarding claim 9, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is self-adhesive tape (20 fig 1). It is noted that the cover tape adheres itself to the asphalt layer 18 fig 1.

Regarding claim 10, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is two layers (22 and 24 fig 1).

Regarding claim 11, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 10 wherein said two layers comprise a first layer (24 fig 1) covering a fastener (16 fig 1) and a second layer (22 fig 1) covering the first layer and a washer of the fastener.

Regarding claim 12, Carr, III et al. discloses an apparatus that can be assembled by the method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said energy absorbing material (20 fig 1) is installed on top

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of the roofing membrane (12 fig 1) in the area directly over and underlying fastener (16 fig 1).

Regarding claim 13, Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate (12 fig 1) having one or more layers of material; at least one fastener (16 fig 1) exposed at a top surface of said substrate; a roof waterproofing membrane (22 fig 1) positioned over said at least one fastener; and a dedicated energy absorbing material (20 fig 1) positioned atop all foregoing elements.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carr, III et al. US Patent 6,502,360.**

Carr, III et al. discloses a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is a self-sticking cover tape composed of cured EPDM (22 fig1); however, Carr, III et al. does not disclose an EPDM with a butyl gum rubber bottom. The applicant's specification discloses in the second paragraph of the detailed description the following: "The energy



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absorbing material may comprise ethylene propylene diene monomer (EPDM), butyl rubber, EPDM with a butyl gum rubber bottom or other flowable material as a combination including at least one of the foregoing, and in one embodiment is affixed to fastener..." It would have been obvious to one of ordinary skill in the art at the time the invention was made as a matter of design choice to use an EPDM or butyl rubber or EPDM with a butyl gum rubber bottom or other flowable material as a combination including at least one of the foregoing to be used in a roofing system because, as stated above, applicant makes an admission that these items are interchangeable.

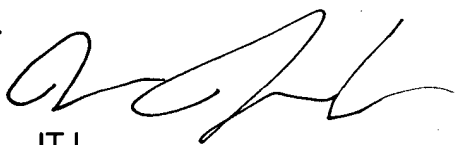
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan T. Junker whose telephone number is (571)272-4020. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JTJ  
12/15/2006



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